REMARKS

The Office Action Summary states claims 2-6 and 12 are "withdrawn from consideration." In fact, claims 2-6 and 12 have been canceled and are not pending in this application. Consequently, the Office Action Summary is misleading in stating that claims 2-6 are 12 are withdrawn from consideration.

Independent claims 1, 18, 28 and 40, as well as dependent claims 19 and 20, have been amended for clarity and to more positively define applicants' contribution to the art.

Claim 7 has been amended to correct a clerical type error.

All claims have been rejected as being anticipated by Irvin, WO 00/30379. Before considering the distinguishing features of the claims over the Irvin reference, a brief discussion of the Irvin reference is in order. Irvin discloses location dependent delivery of a message, particularly a broadcast message. Mobile terminal 100 stores location data in position memory 170 (Fig. 2). The location data can comprise, e.g., latitude and longitude values, as for example, shown by location data 290 in Fig. 4. The location data relate to the location of mobile terminal 100 or to another location that is manually set into the system or is set into the system by some other means; see page 11, lines 27-24. A message includes header 205 having the format illustrated in Fig. 3. The header includes a Target Area of Reception field 250. Field 250 specifies a geographic area for which the message has relevance; see page 10, lines 15-19. In response to the mobile terminal receiving a message, the mobile terminal checks to determine whether the location specified by the location data in memory 170 falls within the geographic area specified by the Target Area of Reception field 250. If the message falls within the geographic areas specified by Field

250, the message is processed as indicated by step 445, Fig 6.

Applicants traverse the rejection of independent claim 43 as being anticipated by Irvin. Applicants cannot agree with the statement on page 9, second full paragraph of the Office Action that Irvin discloses modifying location data as part of delivery of a message initiated to detect a user of a service instance associated with the user by a service instance element. The Office Action incorrectly says modification of the location data, as required by claim 43, is disclosed in Irvin by the Abstract, Figures 1 and 2, page 10, lines 6-14, 23, 24 and page 11, lines 1-6. The foregoing passages mentioned in the Office Action simply concern specifying the Target Area of Reception field. While the specifying the Target Area of Reception Field could be equated to the location data of claim 43, Irvin has no disclosure of such a field being modified as a result of the "service." In this regard, the process message step 445 of Fig. 3 of Irvin would modify the location data 290 stored in position memory 170. However, Irvin has no such disclosure. Consequently, the Examiner is reading something into Irvin that Irvin does not disclose.

If the position of the Office Action is that the modification feature of claim 43 is inherent in Irvin, the Examiner is reminded of the proper requirements for a rejection based on inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F3d 1531, 1534, 28 USPQ 1955, 1957 (Federal Circuit 1993); in Re Oelrich, 666 F2d 578, 58, 582, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary

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skill in the art. Inherency may not be established by probabilities or probabilities. The

mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Roberston 169 F3d 743, 745, 49 UDSPQ 2nd 1949, 1950-1951 (Federal Circuit

1999). In relying upon a theory of inherency, the examiner must provide a basis in fact or

technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the prior art. Ex parte Levy, USPQ

2nd 1461, 1464 (Board of Patent Appeals and Interferences 1990). The office action does

not meet these standards if the position of the Examiner is that Irwin inherently includes

the modification feature of claim 43.

Independent claims 1 and 18 have been amended to require the program code

instance to be customized to a transaction in respect to which the service is to be delivered.

Claim 1, as amended, is patentable over Irvin by requiring "a user-associated instance of

executable program code, customized for said transaction" to be stored upon the user

conducting a transaction. In addition, when the user arrives at a trigger location,

"execution of the user-associated program code instance" is initiated. Similar

requirements are in claim 18.

While Irvin discloses storing location data for triggering an activity (processing of a

received message in step 445 in Fig. 6), the reference does not disclose storing a program

code instance. In particular, Irvin does not disclose storing a program code instance that is

customized to a particular user transaction. The position on page 2 of the Office Action

that the Broadcast Group code field of a message header is properly equated with the "user-

associated instance of program code" is untenable. The contents of the Irvin code field

235 Irvin merely identify a Broadcast Group intended to receive a broadcast message; see Irvin, page 10, lines 13 and 14. Field 235 clearly does not hold an executable program code. Thus the statement in the Office Action that Irvin discloses a location match that results in "initiating execution of the Broadcast Group code field to deliver the particular message" is wrong. The code in field 235 is simply compared in step 410 of Fig. 6 to a list of Broadcast Group codes held in memory 150; see page 13, lines 19 and 20. In Irvin, if a match is found, processing is continued by control unit 102 of terminal 100. Further, Irvin has no disclosure about customizing an executable program code instance to a particular transaction. If the Examiner is relying on inherency, he has not met the burden previously discussed in this response. Based on the foregoing, claims 1 and 18 and the claims dependent thereon, namely claims 7-11, 13-17 and 21-27, are clearly allowable over Irvin.

Claim 28, as amended, distinguishes patentably over Irvin by requiring "passing the service token from the mobile entity to the service provider system where the service provider system checks that the service token originates from a party for which it is willing to provide service delivery before initiating delivery to the user of said particular service as identified by said service provider." Claim 40 includes a similar requirement. Firstly, applicants cannot agree with the assertion on page 7 of the Office Action that the service token of claims 28 and 40 is disclosed in Irvin by the transmitter header of the received message. The Examiner must provide a basis for this conclusion; see the previous discussion about inherency.

Further, even if one were willing to accept the assertion in the Office Action that the service token is found in Irvin by the transmission header of the received message, Irvin

does not disclose sending this token from the mobile entity to a service system to initiate service delivery. There is no rational reason to send the token from the mobile entity to a service system in the Irvin system since the "service" end is a message received and handled at mobile terminal 100. There is no plausible reason to send the header of the received message to a service system. In addition, Irvin does not disclose service system checking wherein a service token originates from a party for whom the service system is willing to provide service delivery. Consequently, independent claims 28 and 40 are not disclosed or made obvious by Irvin, and the claims dependent thereon, namely claims 29-39, 41 and 42, are allowable with claims 28 and 40.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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